

PATENT

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Mark Robert Funk et al.

Application: **METHOD, APPARATUS AND COMPUTER PROGRAM
PRODUCT FOR IMPLEMENTING BREAKPOINT BASED
PERFORMANCE MEASUREMENT**

Serial No.: 10/616,525

Filing Date: July 10, 2003

Art Unit: 2192

Examiner: J. Derek Rutten

Case: ROC920020205US1

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Chicago, Illinois 60611

Mail Stop **Appeal Brief Patents**
Honorable Commissioner Of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

In response to the Examiner's Answer mailed May 28, 2008, Applicants reply to the arguments raised by the Examiner as follows. For the reasons set forth in the Brief on Appeal and below, it is submitted that the Board should reverse the final rejections of claims 1-2, 4-11, 13 and 14.

In the analysis, for example, at pages 3-7, the Examiner incorrectly indicates certain claimed subject matter is present in the prior art. The scope and content of the prior art is believed to be accurately described at pages 22-25 of Applicants' Brief on appeal.

The Examiner maintains that the Bickle et al. and Rosenberg publications and the Carter et al. and Dreyer et al. patent show all of the claimed limitations of claim 1. Applicants respectfully submit that this conclusion is simply incorrect.

For example, contrary to the Examiner's assertions, the Carter et al. patent provides no suggestion of hardware instructions, as taught and claimed by applicants. Applicants respectfully submit that Rosenberg teaches conventional breakpoints, and that Rosenberg does not teach any "special hardware instruction", nor any equivalent hardware instruction. The combined teachings of the Bickle, Rosenberg, Dreyer et al., and Carter et al. references cannot be interpreted as being equivalent to or as suggesting the steps recited in claim 1 of inserting a start breakpoint instruction and a stop breakpoint instruction in hardware instructions; executing said hardware instructions and suspending processing of said hardware instructions responsive to executing said start breakpoint instruction; and responsive to executing said start breakpoint instruction generating a processor interrupt for entering interrupt handler instructions and calling breakpoint instructions, and that said breakpoint instructions generating a start processing instruction to return processing from said interrupt handler instructions to the hardware instructions and starting said defined set of hardware counters, responsive to said generated start processing instruction, taught and claimed by applicants.

Claims in an application should be given their broadest reasonable interpretation consistent with the specification, and the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. It is the prior art itself, and not the applicants' disclosure, that must establish the obviousness of the claimed subject matter.

Contrary to the Examiner's statements, only Applicants teach a method, apparatus, and computer program product for implementing breakpoint based performance measurement as recited in independent claims 1, 6, and 11.

Applicants submit that the prior art provides no teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art to achieve the claimed invention, as recited in independent claims 1, 6, and 11. The reason why the artisan would have been led to do that which the claims specify as the invention must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art.

Applicants respectfully submit that the prior art provides no teaching, suggestion or inference to achieve the claimed invention as recited by the separately patentable claims 1, 4, 6, 7, and 11.

CONCLUSION

For the reasons set forth here and in the Appeal Brief for Applicant, it is submitted that each of claims 1, 4, 6, 7, and 11 is separately patentable and the rejections of all the claims 1-2, 4-11, 13, and 14 should be reversed.

Respectfully submitted,

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